

REMARKS

Claims 1-37 are pending in the subject application. Claims 23-37 have been withdrawn from consideration. In the present Office Action, claims 1-22 stand rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses the rejection.

The grounds for rejection presented in the present Office Action follow.

I. The Examiner rejected claims 1-5, 13-15, and 22 under 35 U.S.C. §103(a) as being obvious over Goldman et al., "Quantitative Double-Label Radiography of Two-Dimensional Protein Gels Using Color Negative Film and Computer Analysis," *Eur. J. Biochem.* 131, 473-480 (1983) ("Goldman") in view of U.S. Patent No. 5,268,486 to Waggoner et al. ("Waggoner") and further in view of Sargent, P.B., *NeuroImage*, vol. 1, No. 4, pp.288-295 (1994) ("Sargent") and Luby-Phelps et al., *Biophysical Journal*, vol. 65, pp 236-242 (July 1993) ("Luby-Phelps").

II. The Examiner rejected claims 6 and 16 under 35 U.S.C. §103(a) as being obvious over Goldman in view of Waggoner and further in view of Sargent and Luby-Phelps as applied in part I above and further in view of Potter, *Electrophoresis*, vol. 11, pp. 415-419 (1990). ("Potter").

III. The Examiner rejected claims 7-12 under 35 U.S.C. §103(a) as being obvious over Goldman in view of Waggoner and further in view of Sargent and Luby-Phelps as applied in part I above and further in view of Anderson et al, *Clinical Chemistry*, vol. 27, No. 11, pp. 1807-1820 (1981). ("Anderson")

IV. The Examiner rejected claims 17-21 under 35 U.S.C. §103(a) as being obvious over Goldman in view of Waggoner and further in view of Sargent and Luby-Phelps and Potter as applied in part II above and further in view of Anderson.

In the January 19, 2007 Office Action, the Examiner had rejected the claims under 35 U.S.C. §103(a) as being obvious over various combinations of the Goldman, Waggoner, Potter and Anderson references cited again in the present Office Action. In

the present Office Action at page 13, under Response to Arguments, the Examiner stated that the arguments submitted in the Response To Office Action dated June 22, 2007 in response to the Office Action mailed January 19, 2007, "were carefully considered and found persuasive." The rejections were therefore modified to include the Sargent and Luby-Phelps references.

Applicants submit herewith the Declaration of Jonathan S. Minden Under 37 C.F.R. §1.131. Dr. Minden is one of the inventors of the subject application. In the Declaration, Dr. Minden states that he and one of his co-inventors on the subject application conceived of the subject matter claimed in the independent claims and most of the other claims in the application prior to July 1993. Attached to the Declaration are pages from a Disclosure of Invention form submitted to the Carnegie Mellon University (CMU) Technology Transfer Office (TTO) prior to July 1993. The Disclosure of Invention describes the claimed subject matter with respect to use of the claimed set of matched dyes in electrophoresis, one of the forms of protein separation that had been reduced to practice at that time. Attached to the Disclosure of Invention form are pages showing two dyes and a schematic for a procedure for their use. Also attached to the Declaration, are copies of signed notebook pages from the laboratory notebook maintained in Dr. Minden's laboratory by students working under Dr. Minden's direction and supervision. According to the Declaration, the pages are dated prior to July 1993. The lab notebook pages demonstrate that a matched set of Cy5 and Cy3 cyanine dyes were being made and used in a protein separation procedure. See the second and forth pages of the lab notebook pages.

The Sargent *NeuroImage* paper was published in November 1994, according to publication data in Science Direct, at <http://www.sciencedirect.com/science>. The Luby-Phelps *Biophysical Journal* paper was published July 1993. Drs. Minden and Waggoner conceived and reduced at least one embodiment of their invention to practice prior to the relevant dates of those publications. Therefore, the Sargent *NeuroImage* paper and the Luby-Phelps *Biophysical Journal* paper are not prior art under 35 U.S.C. §102(a) or §103.

The test for patentability under 35 U.S.C. §103(a) requires that (1) the scope and content of the prior art be determined; (2) differences between the prior art and the claims at issue be ascertained; and (3) the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. See "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 72 Fed. Reg. 57526, 57527 (Oct. 10, 2007) (hereinafter "Guidelines"). In an obviousness analysis, the controlling question is simply whether the differences between the prior art and the claimed invention are such that, despite the differences, the invention would have been obvious to one of ordinary skill in the art. See Guidelines at 57528 (The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts, particularly the differences between the claims and the prior art).

The Examiner has acknowledged in the present Office Action that the combination of the Goldman, Waggoner, Potter and Anderson references do not render the claimed subject matter obvious. The Sargent and Luby-Phelps references relied on by the Examiner are not prior art. Applicants submit that the claimed method is novel and nonobvious over the prior art. The significant differences between the cited references and the claimed subject matter were not obvious at the time of the invention.

Reconsideration of the claims and allowance thereof are respectfully requested.

CONCLUSION

Applicants submit that claims 1-22 of the subject application recite novel and non-obvious methods of comparing protein compositions between at least two different samples using a set of matched luminescent dyes. In view of the Remarks submitted herein together with the Declaration of Jonathan S. Minden Under 37 C.F.R. §1.131, Applicants respectfully submit that all claims in the subject application are in condition for allowance. Accordingly, reconsideration and allowance of all pending claims are earnestly solicited. If the Examiner agrees that a generic claims is allowable, consideration and allowance of the withdrawn species claims 23-32 are respectfully requested.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,

  
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